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10/758,365	01/15/2004	Dean G. Karahalios	31132.141	5308
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HAYNES AND BOONE, LLP 901 MAIN ST SUITE 3100 DALLAS, TX 75202				
EXAMINER REIMERS, ANNETTE R				
ART UNIT 3733				
PAPER NUMBER				

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Please find below and/or attached an Office communication concerning this application or proceeding.



## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on July 03, 2006 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rabbe et al. (U.S. Patent Number 5,702,453).

Rabbe et al. discloses various embodiments of a vertebral implant comprising a biologic strut/tubular body, 21, sized to fit between two vertebral endplates, a pair of ring-shaped, furrowed cleat assemblies, 22, each cleat comprising an outer end wall, an inner end wall, and a side wall which defines a hollow bore, wherein spikes, 91 or 120, extend from each outer end wall, and wherein each hollow bore is sized to fit over an end of the tubular body and is configured to slidably pass from the end along at least a

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portion of the length of the tubular body directly in an axial direction (see Figures 3 and 7 and column 7, lines 38-43 and 66-67 and column 8, lines 1-8). Furthermore, prior to interposition between the two vertebral endplates, the tubular body is slidably passed through the hollow bores in each of the cleat assemblies, and wherein the spikes on each outer end wall are directed away from each other and extend toward the opposite ends of the tubular body without extending past the opposite ends of the tubular body (see Figures 3 and 7 and column 7, lines 38-43 and 66-67 and column 8, lines 1-8).

The vertebral implant comprises an attachment assembly for attaching the tubular body to the cleat assemblies, comprising threaded apertures extending through the side walls of each of the cleat assemblies and a set screw, 24, attachment member extendable through the apertures into contact with the tubular body, wherein the set screws are extended through each of the threaded apertures after a distracting force varies the space between vertebral endplates to create the desired vertebral alignment (see column 8, lines 13-28). Openings, sized to permit graft material entry into the hollow bore, extend through the side walls of each of the cleat assemblies (see column 3, lines 42-45 and column 4, lines 55-57). The inner end wall of each of the cleat assemblies is provided with alignment positions for aligning and positioning the cleat assemblies and the outer end wall of the cleat assemblies is angled with respect to the inner end wall (see Figures 3, 9 and 10).

With regard to the statement of intended use and other functional statements, e.g., "each hollow bore . . . is configured to slidably pass from the end along at least a portion of the length of the tubular body directly in an axial direction" they do not impose

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any structural limitations on the claims distinguishable over Rabbe et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabbe et al. (U.S. Patent Number 5,702,453).

Rabbe et al. disclose the claimed invention except for the hollow bore of each cleat assembly being smooth. It would have been an obvious matter of design choice to construct the device of Rabbe et al. having the hollow bore of each cleat assembly being smooth, since applicant has not disclosed that having the hollow bore of each cleat assembly being smooth solves any stated problem or is for any particular purpose

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and it appears that the invention would perform equally well with the hollow bore of each cleat assembly not being smooth.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabbe et al. (U.S. Patent Number 5,702,453).

Rabbe et al. disclose the claimed invention except the hollow bore having a diameter between 13mm and 25mm and the angle between the outer end wall and the inner end wall being between 4 and 15 degrees. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Rabbe et al. with the hollow bore having a diameter between 13mm and 25mm and the angle between the outer end wall and the inner end wall being between 4 and 15 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

***Allowable Subject Matter***

Claims 21-24 are allowed.

***Response to Arguments***

Applicant's arguments filed on July 03, 2006 have been fully considered, but they are not persuasive. Examiner respectfully disagrees with applicant's argument that because the endplates of Rabbe et al. are threaded that they do not move directly in an axial direction. The threading does not prevent the endplates from moving directly in an axial direction, and the endplates do move directly in an axial direction, i.e., there is no side-to-side movement. Furthermore, applicant is not claiming that the endplates are

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“configured to slidably pass from the end along at least a portion of the length of the tubular body directly in an axial direction,” applicant is claiming that “each hollow bore . . . is configured to slidably pass from the end along at least a portion of the length of the tubular body directly in an axial direction.” As stated above, Rabbe et al. disclose “each hollow bore . . . is configured to slidably pass from the end along at least a portion of the length of the tubular body directly in an axial direction” (see column 7, lines 38-43 and 66-67 and column 8, lines 1-8). As previously stated, it appears that there is a typographical error in the Rabbe et al. patent. Specifically, in column 7, lines 41-42, “each of the end caps” should be “each of the endplates”, since the end caps, i.e. 23 do not have any threading. Therefore, logically the inventor is referring to the endplates, i.e. 22. This same error occurs again in column 8, lines 4-5. The internal threads, i.e. 41, are found on the endplates, i.e. 22, not on the end caps, i.e. 23.

Furthermore, as stated above, with regard to the statement of intended use and other functional statements, e.g., “each hollow bore . . . is configured to slidably pass from the end along at least a portion of the length of the tubular body directly in an axial direction” they do not impose any structural limitations on the claims distinguishable over Rabbe et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Moreover, the manner in which a device is intended to be employed

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does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

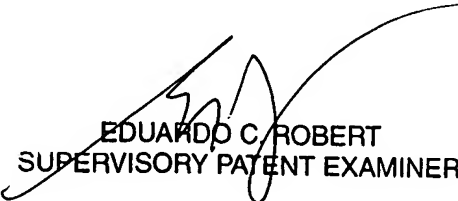
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER